



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,155	11/25/2003	Valdemar Portney	L-1632CA	5547
26822	7590	06/21/2005	EXAMINER	
WALTER A. HACKLER 2372 S.E. BRISTOL, SUITE B NEWPORT BEACH, CA 92660-0755			MILLER, CHERYL L	
			ART UNIT	PAPER NUMBER
			3738	

DATE MAILED: 06/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/721,155	Applicant(s) PORTNEY, VALDEMAR	
	Examiner Cheryl Miller	Art Unit 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1, 4, 5, 8 and 27-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 5, 8, and 27-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments with respect to claims 1, 4, 5, 8, and 21-29 have been considered but are moot in view of the new ground(s) of rejection. However, some of the rejections have been maintained, therefore the examiner has responded to the corresponding arguments.

**It is first noted to the applicant, that the amended claims have been broadened in the respect that now the slit only need to go in and through the anterior surface. Previously, the claim required the slit to extend in and through the *entire optic*, however by the amendment, the slit is only required to go through the anterior surface (not necessarily through the entire optic). Language such as “slit formed in and through the primary intraocular lens optic” (without anterior surface), or “slit formed in and through the lens optic, the slit extending into the anterior surface and out the peripheral edge” would overcome some of the current rejections.**

The applicant has argued that Werblin et al. (US 5,968,094) does not disclose an optic region overhanging the slit. The examiner disagrees. Referring to claim 1, the primary lens (as seen in fig.6a and 6b) of Werblin does disclose a slit with an overhanging portion, see attachment 1. Referring to claim 27, it is noted that an overhanging portion is not recited in the claim.

The applicant has argued that Portney (US 6,113,633) does not disclose an overhanging portion over the slit. The examiner disagrees. Referring to claim 1, the overhanging portion may be considered to be the top of Portney's pocket (pocket flap 31). Referring to claim 27, it is noted to the applicant, that an overhanging portion is not recited in the claim.

Art Unit: 3738

The applicant has argued that Smith (US 4,842,601) does not disclose an overhanging portion, over the slit and anterior surface. The examiner disagrees. Referring to claim 1, see attachment 2 for explanation. Referring to claim 27, an overhanging portion has not been claimed.

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 8, 27, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Werblin et al. (US 5,968,094, cited previously). See figures 6-8 and respective portions of the specification. Werblin discloses a IOL system (fig. 8a, 8b) comprising a primary IOL (seen in fig. 6a, 6b) having a slit (see attachment 1) formed in and through the lens optic anterior, adjacent the peripheral edge, the optic having an optic region overhanging the slit and anterior surface (see attachment 1) and having attachment means fixed to the optic (haptics seen in fig. 6a), Werblin also discloses a secondary IOL (fig. 7a, 7b) having a narrow attachment tab (see attachment 2) extending generally radially outward to penetrate the slit of the primary IOL (fig. 8a, 8b) and lying under the overhanging optic region. Werblin discloses a thickness claimed

Art Unit: 3738

(col.5, lines 11-17; 1.88 mm comprises at least three pieces, therefore, one piece would have the thickness claimed). Werblin discloses a dual optic system (fig.8).

Claims 1, 4, 5, 27, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Portney (US 6,113,633, cited previously). Referring to claims 1, 4, and 5, Portney discloses an IOL system comprising a primary IOL (11, seen in fig.5) having an anterior surface (37), posterior surface (33), peripheral edge, power, and a thin slit (opening 34 and inside of pocket) formed in and through the lens optic anterior surface adjacent the peripheral edge, the optic having an optic region (31) overhanging the slit (pocket) and anterior surface (37; seen in fig.6, 7, 8), and an attachment means (26) fixed to the optic, and further a secondary IOL (32) having optic with an anterior surface, posterior surface, peripheral edge, and an attachment tab (reduced thickness area; col.3, lines 32-36; see attachment 3) extending generally radially outward from the edge, sized to penetrate the slit on the primary IOL (fig.6-8), and lie under the overhang (31) wherein the secondary IOL posterior surface is lying against the primary IOL anterior surface (fig.7, 8). Portney discloses the secondary IOL to have a plurality of tabs (col.5, lines 19-25), the tabs being tapered (col.3, lines 32-36; fig.6, 8).

Referring to claims 27 and 29, Portney discloses a primary IOL (11) comprising an optic having an edge, anterior surface (31 or 37), posterior surface (33), power, and at least one slit (34; entire pocket plus the openings) formed in and through the primary IOL anterior surface adjacent the edge (see attachment 4) and without penetration of the posterior surface (33) and an attachment means (26) fixed to the optic. Portney discloses a dual optic system (fig.7, 8).

Claims 1, 4, 8, 27, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Smith (US 4,842,601, cited previously). Smith discloses an IOL system (130; see fig.11 and respective portions of the specification) comprising a primary IOL (132) having an anterior surface (132a+ top surface of 38a), posterior surface (132b), peripheral edge (38c), power (col.8, lines 29-50), and a thin slit (40, 39; see fig.5, 6, 8, 11) formed in and through the lens optic anterior surface adjacent the peripheral edge, the optic including an optic region (38b) overhanging the slit (39) and anterior surface (top of 38a), and an attachment means (outermost edge may serve as an attachment means, or 54 may be considered an attachment means) fixed to the optic, and further a secondary IOL (134) having optic with an anterior surface (134b), posterior surface (134a), peripheral edge, and an attachment tab (reduced thickness area fig.11, 48, 148; which contacts the primary IOL) extending generally radially outward from the edge, sized to penetrate the slit (39) on the primary IOL (fig.11, 8) and lie under the overhang (38b), wherein the secondary IOL posterior surface is lying against the primary IOL anterior surface (fig.11, see attachment 5, 6).

Claims 1, 4, 5, 8, and 27-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Portney (US 6,197,058 B1, cited previously). Referring to claims 1, 4, and 5, Portney discloses an IOL system comprising a primary IOL (62) having an anterior surface (76), posterior surface (bottom surface), peripheral edge (78), power, and a thin slit (74) formed in and through the lens optic anterior surface adjacent the peripheral edge (78), the optic having an optic region (86) overhanging the slit (74) and anterior surface (76), and an attachment means (72) fixed to the optic, and further a secondary IOL (64) having optic with an anterior surface (top surface),

Art Unit: 3738

posterior surface (bottom surface), peripheral edge, and an attachment tab (80; fig. 7) extending generally radially outward from the edge, sized to penetrate the slit (74) on the primary IOL, and lie under the overhang (86) wherein the secondary IOL posterior surface is lying against the primary IOL anterior surface (fig. 5, 6, 8). Portney discloses the secondary IOL to have a plurality of tabs (80; fig. 7), the tabs being tapered (fig. 4-6, 8).

Referring to claims 27 and 29, Portney discloses a primary IOL (62) comprising an optic having an edge (78), anterior surface (76), posterior surface (bottom surface), power, and at least one slit (74) formed in and through the primary IOL anterior surface adjacent the edge and without penetration of the posterior surface (bottom surface) and an attachment means (72) fixed to the optic. Portney discloses a dual optic system (see figs).

Referring to claims 8 and 28, Portney discloses the powers and dimensions claimed (col. 3, lines 15-25, 26-28, 56-60).

### *Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 3738

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Miller whose telephone number is (571) 272-4755. The examiner can normally be reached on Monday-Friday 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4755. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

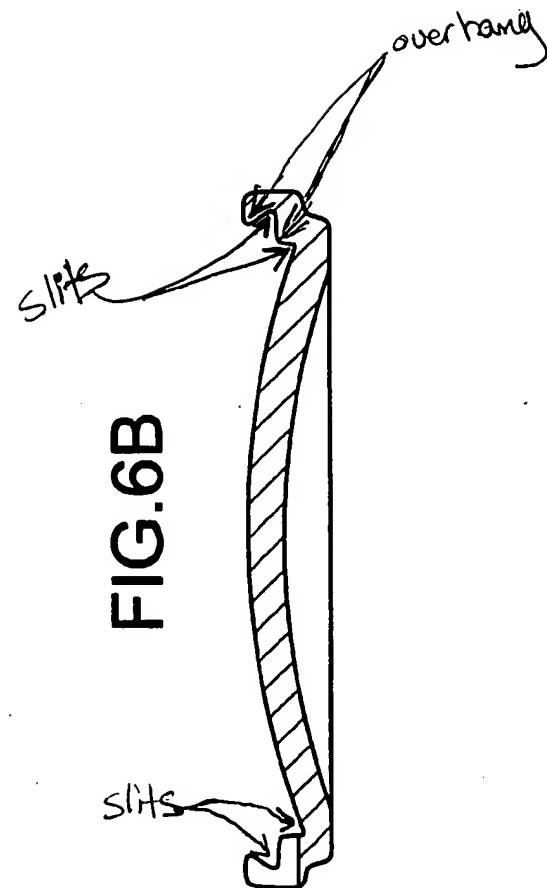
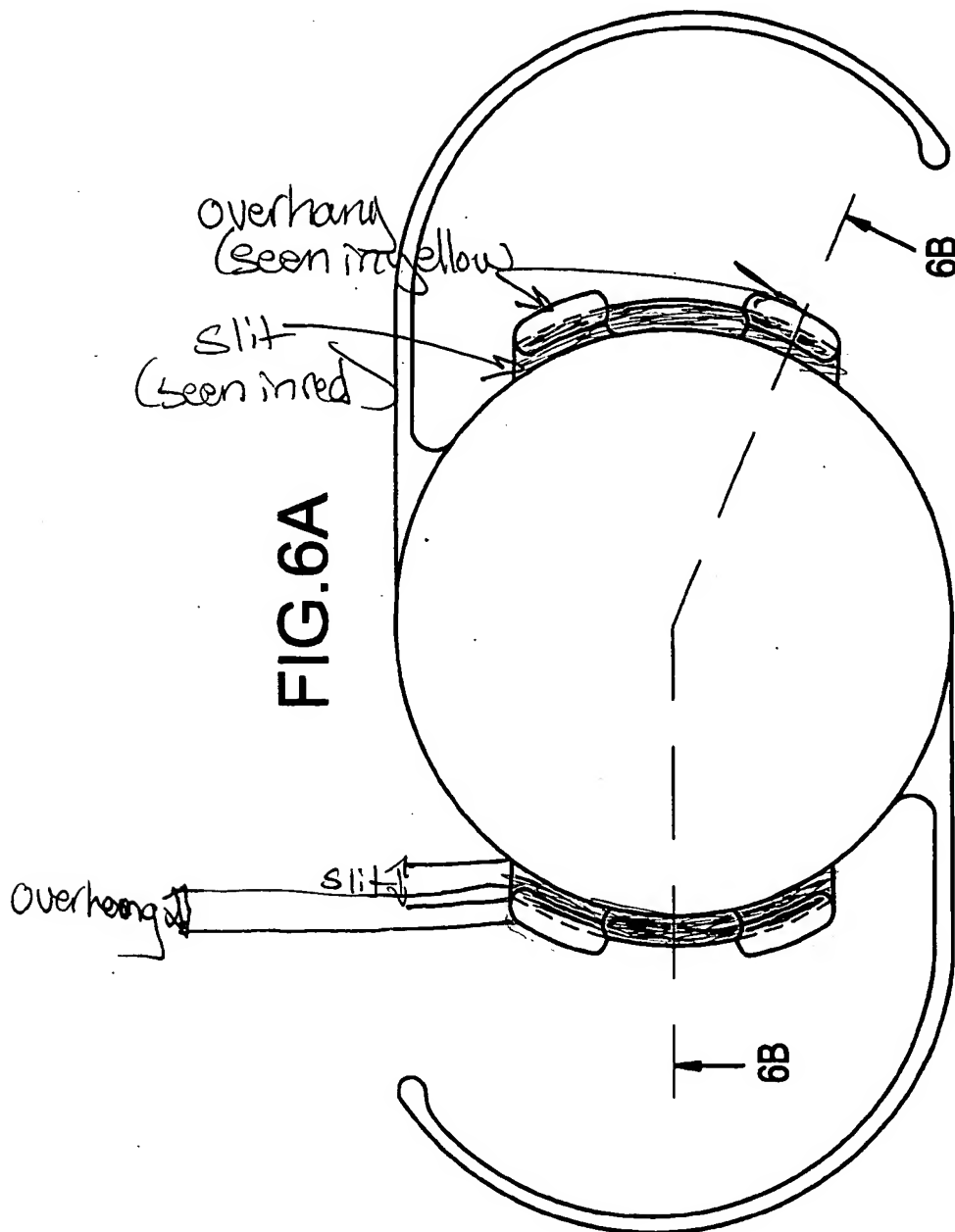


Cheryl Miller



BRUCE SNOW  
PRIMARY EXAMINER





Attachment #2 (marked up)

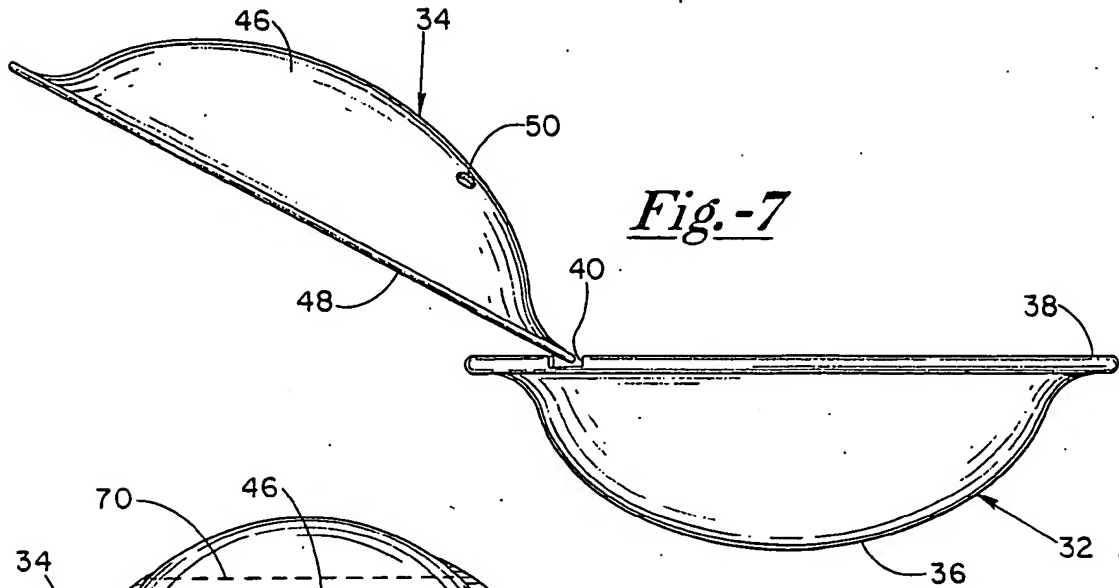


Fig. -7

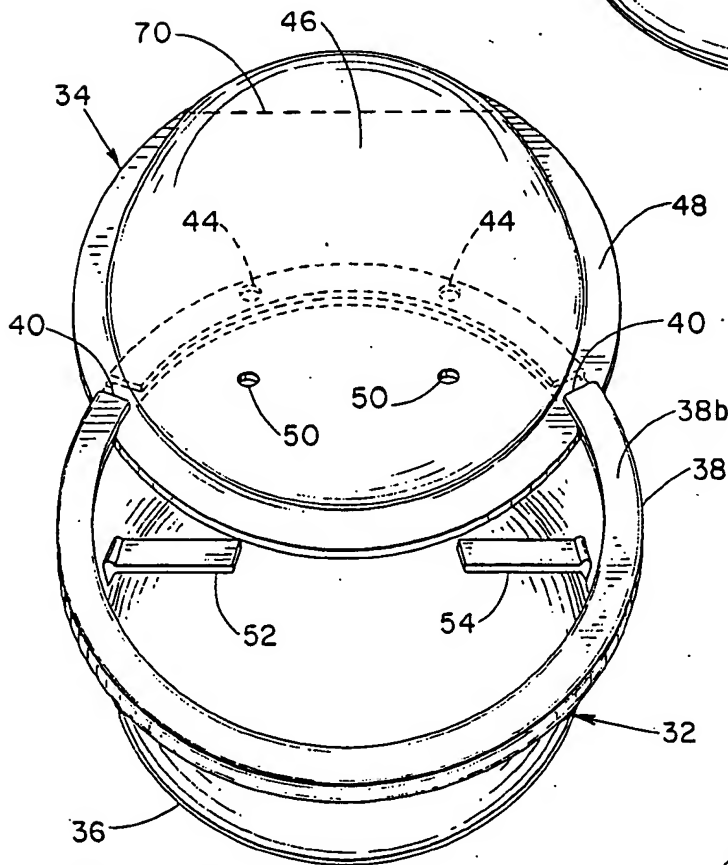


Fig. -8

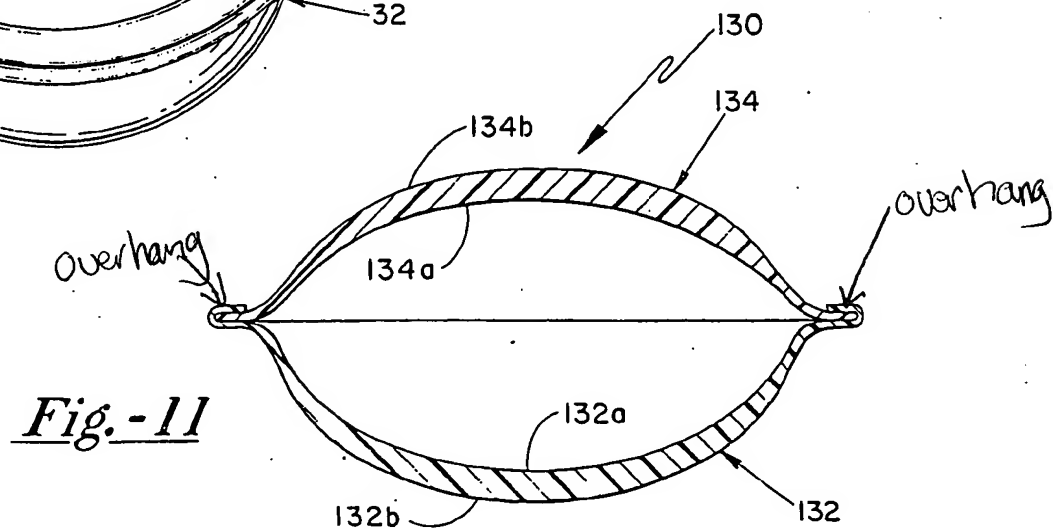


Fig. -11